

### **REMARKS**

Claims 1-33 are pending in the present application.

In paragraph 2 of the Action, the Examiner rejects claims 1, 3-9, 11, 13-17, 23, 25, 26 and 28-33 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5, 675,672 to Nakabayashi ("Nakabayashi"), further in view of U.S. Patent No. 5, 491,760 to Withgott et al. ("Withgott"). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some motivation to combine the cited references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claims 1, 3-9, 11, 13-17, 23, 25, 26 and 28-33 are not rendered unpatentable over the combination of Nakabayashi and Withgott because the Examiner fails to establish a *prima facie* case of obviousness as discussed below.

In rejecting claim 1, the Examiner notes that Nakabayashi fails to disclose each and every claimed element. More specifically, the Examiner notes that Nakabayashi fails to disclose converting coherent pieces of the information in the images to a coded representation of the extent of the pieces of information in at least one dimension. Therefore, the Examiner relies on the teachings of Withgott to overcome the deficiencies of Nakabayashi. However, the Examiner fails to provide proper motivation

for combining the cited references. Furthermore, the combination fails to disclose each and every claimed element.

With regard to motivation, the Examiner asserts that it would have been obvious to one skilled in the art to “incorporate the teaching of Withgott’s overlap image processing system into Nakabayashi system” [sic] in order to “provide a document image segmenting into word image units and the word units are evaluated in accordance with morphological image properties of the word units, such as word shape.” To support this assertion, the Examiner points to column 3, lines 54-61 of Withgott. This assertion is unfounded for the following reasons.

First, nowhere in Withgott is there any disclosure or suggestion of an “overlap image processing system” as asserted by the Examiner. To the contrary, Withgott discloses a method and apparatus for summarizing a document without having to first decode the document image to optical character codes, i.e., without performing OCR. Nowhere in Withgott is there any disclosure or suggestion of determining the overlap between two images, much less of assembling the images to form a composite image as claimed. Accordingly, it is unclear to Applicants what “overlap image processing system” the Examiner believes Withgott teaches.

Second, one skilled in the art would not be motivated to modify the OCR system of Nakabayashi to include non-OCR functionality, such as providing “a document image segmenting into word image units and the word units are evaluated in accordance with morphological image properties of the word units, such as word shape,” taught by

Withgott because they are directed to completely divergent systems. Nakabayashi is directed to an OCR image decoding system and Withgott is specifically directed to a system which prevents the need for image decoding such as OCR.

Finally, even if one skilled in the art were motivated to combine Nakabayashi and Withgott, which Applicants do not concede, the combination would still fail to render claims 1, 3-9, 11, 13-17, 23, 25, 26 and 28-33 unpatentable because the combination fails to disclose each and every claimed element as discussed below.

In rejecting claims 1, 3-9, 11, 13-17, 23, 25, 26 and 28-33, the Examiner asserts that Withgott discloses converting coherent pieces of information in the images to a coded representation of the extent of the pieces of information in at least one dimension inasmuch as Withgott discloses "blobifying" words in the document such that there is no space between the letter within a word. (See Figs. 18 and 19, and column 16, line 61 to column 17, lines 20 of Withgott.) Although, Withgott's filtering method may distinguish the words in a document, nowhere in Withgott is there any disclosure or suggestion of comparing the blobified words to determine the overlap between images as claimed. To the contrary, Withgott is not concerned with overlapping images.

Since Nakabayashi and Withgott both fail to disclose or suggest: a device for recording information that includes a processing device for converting coherent pieces of information in the images to a coded representation of the extent of the pieces of information in at least one dimension, and a comparison device for comparing the extent of the coherent pieces of information for determining an overlap position between

the images, as recited in claim 1; a method for recording information that includes converting coherent pieces of the information in the image to a coded representation of the extent of the pieces of information, and comparing the extent of the coherent pieces of information in the images, as recited in claim 11; a method for recording information that includes identifying the graphical extent, in at least one dimension, of elements in the image, and determining the overlap between pairs of images based on a comparison of the graphical extent of the elements, as recited in claim 30; or a device for recording information that includes a processor which identifies the graphical extent, in at least one dimension, of elements in the image, and a comparator which determines the overlap between pairs of images based on a comparison of the graphical extent of the element as recited in claim 30, the combination of these two references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Nakabayashi and Withgott, the combination would still fail to render claims 1, 3-9, 11, 13-17, 23, 25, 26 and 28-33 unpatentable because the combination fails to disclose each and every claimed element. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 3-9, 11, 13-17, 23, 25, 26 and 28-33 under 35 U.S.C. § 103(a).

In paragraph 3 of the Action, the Examiner rejects claims 10 and 18-22 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nakabayashi in view of Withgott, further in view of U.S. Patent No. 5,220,621 to Saitoh ("Saitoh"). Applicants respectfully traverse this rejection.

Claims 10 and 18-22 variously depend from independent claims 1 and 11. Therefore, claims 10 and 18-22 are patentable over the combination of Nakabayashi and Withgott for at least those reasons presented above with respect to claims 1 and 11.

Saitoh teaches an image character recognition system, which utilizes a generalized Hough transformation, and is silent with respect to the features discussed above. Accordingly, Saitoh fails to overcome the deficiencies of Nakabayashi and Withgott.

Since Nakabayashi, Withgott and Saitoh each fail to disclose or suggest a method or device for recording information by obtaining at least two images having partially overlapping content that includes, converting coherent pieces of information in the images to a coded representation of the extent of the pieces of information in at least one dimension, and comparing the extent of the coherent pieces of information in the images as claimed, the combination of these three references cannot possibly disclose or suggest said features. Therefore, even if one skilled in the art were motivated to combine Nakabayashi, Withgott, and Saitoh, which Applicants do not concede, the combination would still fail to render claims 10 and 18-22 unpatentable because the combination fails to disclose each and every claimed element. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 10 and 18-22 under 35 U.S.C. § 103(a).

The application is in condition for allowance. Notice of same is earnestly

solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at telephone number (703) 205-8000, which is located in the Washington, DC area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: October 13, 2006

Respectfully submitted,

By Penny Caudle *Penny Caudle*  
Michael K. Mutter *Reg. # 46,601*  
Registration No.: 29,680  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Rd., Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicants